

REMARKS

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of September 13, 2005 is respectfully requested.

In item 3 on page 2 of the Office Action, the Examiner rejected claims 30-33 under 35 U.S.C. § 112, first paragraph, as not complying with the enablement requirement due to the limitation "said woodmeal being incompletely homogenized in said thermosoftening resin material." However, as indicated above, independent claim 30 has now been amended so as to delete the subject limitation. Therefore, it is submitted that the Examiner's enablement rejection has been obviated, and the Examiner is therefore requested to withdraw this rejection.

Claims 15-32 are presently pending in this application. In the outstanding Office Action, the Examiner rejected claims 15-19, 21, 24, and 27 as being unpatentable over the Nakada reference (US 5,792,302) in view of the Nishibori reference (US 5,869,138); and rejected dependent claims 20, 22, 23, 25, 26, 28, and 29 as being unpatentable over the Nakada reference in view of the Nishibori reference, and further in view of the Young reference (US 3,802,291) in view of the Kiyoshi reference (Japanese Publication No. 07117326) and further in view of the Uchida reference (US 4,581,954). However, both independent claims 15 and 30 have now been amended so as to clarify the distinctions between the present invention and the prior art. Therefore, for the reasons discussed below, it is respectfully submitted that amended independent claims 15 and 30, and the claims that depend therefrom, are clearly patentable over the prior art of record.

The present invention is directed to a steering wheel with an annular rim section having a structure that replicates natural wood. In particular, an annular rim section of the steering wheel includes arcuate-shaped and elongated rim elements mounted on a core, and each of the elongated rim elements is formed of thermosoftening synthetic resin material blended with woodmeal so that the elongated rim elements have an outer surface *of the thermosoftening synthetic resin material and the woodmeal*. As recited in each of amended independent claims 15 and 30, and as described on page 13, line 27 through page 14, line 14 of the original specification, the outer surface has a mold-formed annular streak pattern extending along a

longitudinal axis of each of the elongated rim elements, and the mold-formed annular streak pattern *is defined by the woodmeal within the thermosoftening synthetic resin material*.

The steering wheel of amended independent claims 15 and 30, in which the outer surface has a mold-formed annular streak pattern defined by woodmeal within thermosoftening synthetic resin material, is much simpler to produce than other steering wheels with conventional imitation-wood outer surfaces. Furthermore, because the *outer surface* includes *woodmeal* along with the thermosoftening synthetic resin material, and because the mold-formed annular streak pattern on the outer surface is *defined by the woodmeal within the thermosoftening synthetic resin material*, the steering wheel will have both an appearance and a feel which is substantially equivalent to a steering wheel formed of natural wood (see page 5, lines 8-13 of the original specification).

The Nakada reference is directed to a method of molding an article such as a steering wheel. In the outstanding Office Action, the Examiner noted that the Nakada reference teaches an annular rim 1a that includes a core 2 and rim elements 3, 4. In particular, as illustrated in Figures 2a through 5, the outer surface of the rim 1a is formed of a *wooden* (i.e., natural wood) layer 4 (see column 3, lines 34-40 of the Nakada reference). Thus, as acknowledged by the Examiner on page 4 of the Office Action, the Nakada reference does not teach rim elements having an outer surface of both thermosoftening synthetic resin material *and* woodmeal. Moreover, it is submitted that the Nakada reference also does not teach or suggest that the outer surface has a mold-formed annular streak pattern *defined by the woodmeal within the thermosoftening synthetic resin material*.

Nonetheless, the Examiner asserted that the Nishibori reference teaches the claimed outer surface of the rim elements. Therefore, the Examiner is apparently taking the position that it would be obvious to replace the natural wood outer surface 4 of the Nakada reference with the surface taught in the Nishibori reference so as to obtain the invention recited in claims 15 and 30 of the present application. However, the Applicants respectfully disagree with the Examiner for the following reasons.

As explained in MPEP chapter 2143, a prima facie case of obviousness requires (1) that the prior art references teach or suggest *all* of the claimed limitations; and (2) that there is some suggestion or motivation to modify or combine the references so as to obtain the claimed invention. In the present case, neither of these requirements has been met.

Firstly, the combination of references applied by the Examiner, even if combined, does not teach or suggest all of the claimed limitations recited in amended claims 15 and 30. As an initial matter, the Nakada reference *does not* teach or suggest any elongated rim elements having an outer surface of thermosoftening synthetic resin material *and* woodmeal, as discussed above. Furthermore, the Nakada reference *does not* teach or suggest that the outer surface has a mold-formed annular streak pattern defined by the woodmeal within the thermosoftening synthetic resin material.

The Nishibori reference teaches a method of forming a pattern on a wood board 11, in which the *surface* of the synthetic wood board 11 is covered with a layer of *thermoplastic resin* 13 so that woodmeal 12 is not exposed on the surface (see column 4, lines 58-61 and Figure 2). Thus, the Nishibori reference also does not disclose or suggest elongated rim elements (or *any* elements) having an outer surface of thermosoftening synthetic resin material *and* woodmeal. Furthermore, the Nishibori reference explains that a pattern can be formed on the surface of the board 11 by a process of grinding the surface to form a large number of wound stripes 15 (shallow cuts or scratches), applying a colorant to the surface of the board 11 having the wound stripes 15 formed therein, and then grinding the surface so as to leave the colorant-filled wound stripes as the wood grain pattern (see column 2, lines 26 through column 3, lines 16 and Figure 5A). In other words, the streak pattern of the Nishibori reference is defined by colorant-filled cuts and scratches. Thus, the Nishibori reference also does not disclose or suggest a *mold-formed* annular streak pattern *defined by woodmeal within a thermosoftening synthetic resin material*.

The Young reference, the Kiyoshi reference, and the Uchida also do not teach or suggest an elongated rim element having an outer surface of thermosoftening synthetic resin material and woodmeal, in which the outer surface has a mold-formed annular streak pattern defined by the

woodmeal within the thermosoftening synthetic resin material. Consequently, because none of the references teach or suggest such a feature, it is submitted that the combination of references does not render the invention as recited in amended independent claims 15 and 30 obvious. Accordingly, it is respectfully submitted that amended independent claims 15 and 30, and the claims that depend therefrom are clearly patentable over the prior art of record.

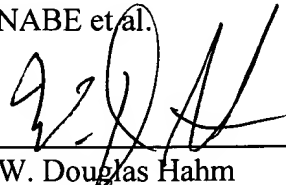
Secondly, there is no suggestion or motivation to modify or combine the references so as to obtain the invention of claims 15 and 30. In this regard, it has been well established that the fact that it *may* be possible to combine references does not render the invention obvious unless the prior art also suggests the *desirability* of the claimed combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, the suggestion of the desirability of such a combination must not come from the Applicant's own disclosure. See *In re Dembiczak* 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In this case, there is no suggestion in the prior art that it is desirable for one of ordinary skill in the art to undergo the *significant* effort involved in modifying the *flat* board, plate or sheet having a resin surface as taught in the Nishibori reference for application to an *arcuate-shaped* rim element as taught in the Nakada reference which, if possible, would ultimately result in a distorted pattern and a steering wheel without a natural wood texture due to the resin-only surface of the Nishibori reference. At best, the prior art indicates that such a combination *might* be possible, but certainly doesn't suggest that the combination is *desirable*. Consequently, it is submitted that one of ordinary skill in the art would not be motivated to combine the references as suggested by the Examiner.

As explained above, the prior art references applied by the Examiner, if combined, do not teach or suggest all of the limitations recited in amended claims 15 and 30. Furthermore, there is no required suggestion or motivation to even make the proposed combination. Therefore, it is respectfully submitted that the prior art does not render the invention recited in amended claims 15 and 30 obvious in view of the prior art.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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